

# GCenegy

Microsoft Word – JBP529Appealbr.doc  
10/24/03 11:26 AM



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Benjamin Wiegand et al.  
Serial No.: 09/731, 342 Art Unit: 1617  
Filed : December 6, 2000 Examiner: Gina C. Yu  
For : PERSONAL CARE FORMULATIONS

I hereby certify that this correspondence is being deposited with the  
United States Postal Service as first class mail in an envelope addressed  
to: Commissioner of Patents and Trademarks, Alexandria, VA 22313-1450 on

November 8, 2003  
(Date of Deposit)

Name of applicant, assignee, or Registered Representative

(Signature)

November 8, 2003  
(Date of Signature)

Assistant Commissioner of Patents and Trademarks  
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

In accordance with the provisions of 37 CFR 1.191,  
Applicant filed a timely Notice of Appeal in the above application  
on September 8, 2003 from the rejections made by the Examiner in  
the Office Action dated May 5, 2003. Three copies of the Appeal  
Brief are enclosed.

**(1) Real Party in Interest**

The real party in interest in the application in this appeal is Applicant's assignee Johnson & Johnson Consumer Companies, Inc., a corporation of New Jersey, a wholly owned subsidiary of Johnson & Johnson, a New Jersey corporation.

**(2) Related Appeals and Interferences**

Applicant is not aware of any related appeals or interferences.

**(3) Status of the Claims**

Claims 1-9 and 11-20 are the claims on appeal, a copy of which are attached hereto in the Appendix to this Brief. No claims stand allowed in this application.

**(4) Status of Amendments**

No amendment was made after receiving the Final rejection dated May 7, 2003. The last Amendment made in this application, dated March 5, 2003, was entered.

**(5) Summary of the Invention**

The present invention relates to a method of depositing a benefit agent on a keratinous surface, the method comprising topically applying to the surface an effective amount of a ringing gel composition including (a) a surfactant phase ; (b) an oil phase; and (c) a benefit agent. Suitable benefit agents include antimicrobial agents, medicament agents, skin emollients, skin moisturizers, skin firming agents, and the like.

**(6) Issues on Appeal**

I) Whether the inventions of claims 1-9 and 11-20 are indefinite under 35 U.S.C. §112 for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

II) Whether the inventions of claims 1, 2, 3, 11-17, and 20 are unpatentable under 35 U.S.C. §103 as being obvious over Herman in view of Santora et al. and Marin et al.

III) Whether the inventions of claims 4-9 are unpatentable under 35 U.S.C. §103 as being obvious over Herman in view of Santora et al. and Marin et al., and further in view of Greenburg et al.

IV) Whether the inventions of claims 1, 18 and 19 are unpatentable under 35 U.S.C. §103 as being obvious over Herman in view of Piechota.

## **(7) Grouping of Claims**

Applicants believe that all of their claims are patentable over the prior art. For purposes of this Appeal, claims 1-9 and 11-20 stand together.

## **(8) Argument**

Claims 1-9 and 11-20 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated that the metes and bounds of the scope of the claims are unascertainable because the terms "benefit agents", "antiinfective", "shaving preparations", "poison ivy products", "poison oak products", "burn products", "anti-diaper rash agents", "prickly heat agents", "sensates", and "make-up preparations" were not defined in the specification. Applicants respectfully traverse this rejection.

Definiteness of claim language must be analyzed, not in a vacuum, but in light of (A) the content of the particular application disclosure; (B) the teachings of the prior art; and (C) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. See M.P.E.P. § 2173.02. Here, each of the benefit agents claimed are conventional active agents used in cosmetic compositions. Indeed, as discussed in the specification, the term "benefit agent" includes any active ingredient that is to be delivered into and/or onto a keratinous surface, such as, the skin, hair or nail at a desired location. See page 3, lines 27-28.

Furthermore, there are many sources that one of ordinary skill in the art would utilize to understand the terms utilized in the present patent application. For example, "Shaving preparations" are described in Harry's Cosmeticology - 7th edition (1982) Part One: The Skin and Skin Products - Chapter 12: Shaving Preparations, pgs. 156-187. "Make-up preparations" are also described in Harry's Cosmeticology - 7th edition (1982) Part One: The Skin and Skin Products - Chapter 17: Face Packs and Masks, Part One: The Skin and Skin Products - Chapter 18: Face Powders and Make-up, Part One: The Skin and Skin Products - Chapter 19: Coloured Make-up Preparations. "Anti-Diaper Rash Products" and "Prickly Heat Products" are described in O-T-C products for diaper rash and prickly heat. J Am Pharm Assoc. 1970 Jan;10(1):19-24. "Poison Ivy Products" and "Poison Oak Products" are described in Skin protectant drug products for over-the-counter human use; final monograph. Final rule. Fed Regist. 2003 Jun 4; 68(107): 33362-81.

Applicants respectfully submit that the benefit agents listed in the present patent application are known and understood by those of ordinary skill in the art. As indicated above, the terms are readily found in the literature. Furthermore, many of the benefit agents are controlled through and listed in the monograph. Applicants respectfully submit that the rejection under 35 U.S.C. §112 is incorrect and request withdrawal of the rejection.

Claims 1, 2, 3, 11-17, and 20 stand rejected under 35 U.S.C. §103 as being obvious over Herman in view of Santora et al. and Marin et al. The Examiner relies upon Herman as disclosing the "that the basic components of ringing gel formulations are oil, water, a surfactant, and a cosurfactant." Herman fails to teach

or suggest Applicants' claimed method of depositing a benefit agent on a keratinous surface. There is nothing in the teachings of Herman that would provide one of ordinary skill in the art with the expectation that the ringing gel composition broadly disclosed by Herman could be used to deposit benefit agents to keratinous surfaces.

Recognizing these deficiencies, the Examiner relies upon Santora and Marin et al. Specifically, the Examiner relies upon Santora as teaching a cleansing and moisturizing surfactant composition comprising nonionic, amphoteric and anionic surfactants. The Examiner relies upon Marin et al. as disclosing a hexagonal liquid crystal composition comprising oily phase, surfactant system and water. The Examiner also relies upon Marin as teaching that the compositions taught therein provide good viscosity, foaming, stability, appearance and cleaning ability. According to the Examiner it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Herman and add the surfactants and cosmetic actives as suggested by Santora and motivated by Marin because of the expectation to have successfully produced a mild and non-greasy skin or hair care composition with viscosity, stability, appearance and good cleansing effects." Applicants respectfully disagree.

The Examiner has failed to provide any teaching or suggestion in either of Herman or Santora et al. that would provide one of ordinary skill in the art with the motivation to incorporate the ingredients taught by Santora et al. into the ringing gel compositions disclosed by Herman. The Examiner relies upon Marin as providing the requisite motivation. The fact that Marin teaches that the Marin compositions provide good viscosity, foaming, stability, appearance and cleaning ability,

would not motivate one of ordinary skill in the art to incorporate the ingredients taught by Santora et al. into the compositions taught by Herman, much less, that the ringing gel composition broadly disclosed by Herman could be used to deposit benefit agents to keratinous surfaces.

Accordingly, Applicants respectfully submit that Herman, Santora et al. and Marin, taken alone or in any combination do not render the present claims obvious for the following reasons: (1) there is no suggestion or motivation in either of Herman, Santora et al. or Marin to modify the compositions of Herman as suggested by the Examiner; (2) even if one of ordinary skill in the art was somehow motivated to incorporate the ingredients taught by Santora et al. into the Herman ringing gel compositions, there is nothing in the teachings of Herman, Santora et al. or Marin that would provide a reasonable expectation that such a modification of the Herman ringing gel compositions would be successful; and (3) even if the references were combinable as suggested by the Examiner, all the claim limitations are not taught or suggested since each of Herman, Santora et al. and Marin fail to teach or suggest Applicants' claimed method of depositing a benefit agent on a keratinous surface. Therefore, the rejection should be withdrawn.

Claims 4-9 stand rejected under 35 U.S.C. §103 as being obvious over Herman in view of Santora et al. and Marin et al., and further in view of Greenburg et al. The Examiner relies upon Greenberg et al. for teaching the specific oil phase recited by claims 4-9. Specifically, the Examiner argues that it would have been obvious to one of ordinary skill in the art to modify the ringing gel composition taught by Herman by incorporating certain ingredients taught by Santora et al. and further modify the



composition by incorporating specific esters taught by Greenberg et al. because of "the expectation to have produced a clear microemulsion skincare composition with a smooth and non-tacky feel."

Greenberg et al. fails to remedy the deficiencies of Herman, Santora and Marin as set forth above. There is nothing in the teachings of Greenberg et al., Herman, Santora, and Marin taken alone or in any combination, that would provide one of ordinary skill in the art with the motivation to incorporate the ingredients taught by Santora et al., Marin, and Greenberg et al. into the ringing gel compositions disclosed by Herman. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Here, the Examiner has failed to provide the requisite motivation for the combination. Further, since neither Santora et al. nor Greenberg et al. disclose ringing gel compositions, Applicants respectfully submit that there would not be a reasonable expectation that the ingredients taught by Santora et al., Marin, and Greenberg et al. could successfully be incorporated into ringing gel compositions.

Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness for the following reasons: (1) there is no suggestion or motivation in any of the references relied upon by the Examiner to modify the compositions of Herman as suggested by the Examiner; (2) even if one of ordinary skill in the art was somehow motivated to incorporate the ingredients taught by Greenberg et al., Santora et al. and Marin into the Herman ringing gel compositions, there is nothing in the teachings of Greenberg et al., Herman, Marin or Santora et al., taken alone or in combination, that would provide a reasonable expectation that

such a modification of the Herman ringing gel compositions would be successful; and (3) even if the references were combinable as suggested by the Examiner, all the claim limitations are not taught or suggested since none of the references teach or suggest Applicants' claimed method of depositing a benefit agent on a keratinous surface. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Claims 1, 18 and 19 stand rejected under 35 U.S.C. §103 as being obvious over Herman in view of Piechota. The Examiner relies upon Piechota for teaching a method for treating acne and the specific oil phase recited by claims 18 and 19. Piechota relates to topical compositions, which can be applied as a relatively low viscosity flowable liquid and which will quickly, upon contact with the warm surface of an animal, turn into a relatively high viscosity, essentially non-flowable, gel. Accordingly, the compositions taught by Piechota are distinct from the ringing gel compositions disclosed by Herman. Indeed, Piechota specifically teaches the disadvantages of compositions in the form of a gel prior to use. See col. 1, line 14 - col. 2, line 15.

It is the Examiner's position that it would have been obvious to one of ordinary skill in the art "to have modified the Herman's composition by adding retinoids or antimicrobial agents and used it to treat acne, as taught by Piechota, because of the expectation of successfully producing a ringing gel composition that may be used for acne treatment." Applicants respectfully traverse. Why would one of ordinary skill in the art be motivated to incorporate the anti-acne ingredients taught by Piechota into the ringing gel compositions taught by Herman when Piechota specifically teaches the disadvantage of compositions

that are in the form of gels prior to use when applying active ingredients to humans and animals?

The Examiner states that Piechota discloses ringing gel compositions. Applicants respectfully disagree. References must be considered in their entirety. Clearly, Piechota is directed to compositions that are not in gel form until after applied to a desired situs. See, for example, col. 2, lines 11-15. Applicants have pointed out that the only disclosure in Piechota of ringing gels is at col. 3, lines 59-66. Here, Piechota is evaluating the effect of different poloxamers. Specifically, Piechota teaches that Pluronic F127 has the ability to form a ringing gel and as such "would not lead one skilled in the art to employ Pluronic F127 to meet the objects of this invention in that such teachings are totally inimical to the objects of this invention; it is taught that the result is a gelled solution at room temperature i.e. one that cannot be filled, stored or dispensed as a flowable liquid." See col. 3, line 66- col. 4, line 5 (emphasis added). Clearly, Piechota teaches away from compositions in the form of a gel prior to use.

The Examiner argues that "the disadvantage of using poloxamers is irrelevant in adding acne agents or antibacterial agents into the ringing gel of Herman for topical use" and that "the specific types of poloxamers referred by Piechota, Poloxamer 407, is neither a required limitation in instant claims or disclosed in Herman." Applicants respectfully submit that the Examiner has misunderstood Applicants' arguments. Applicants have pointed to this Example as evidence that Piechota teaches that compositions for topical application in the form of gels prior to use are not desirable due to flow problems. Clearly, one of ordinary skill in the art, armed with the disclosure of Piechota, would expect that the gel compositions taught by Herman

would not be useful for delivering active ingredients, such as anti-acne agents, due to the fact that they are in the form of a gel. Thus, Piechota fails to provide the requisite motivation for incorporating an anti-acne active into the compositions of Herman. Indeed, Piechota specifically teaches away from such a modification due to flow problems. Accordingly, one of ordinary skill in the art would not have been motivated to combine the teachings of Piechota with the teachings of Herman. Applicants, therefore, respectfully request that this rejection be withdrawn.

For the above reasons, Applicants respectfully request that the rejections of record be reversed and that all claims on appeal be allowed.

Respectfully submitted,

---

James P. Barr

Reg. No.

Attorney for Applicant

Filed under Rule 1.34(a)

Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, NJ 08933-7003  
(732) 524-2826  
November 8, 2003

## APPENDIX

### (9) Claims on Appeal

1. A method of depositing a benefit agent on a keratinous surface, said method comprising topically applying to said surface an effective amount of a ringing gel composition comprising (a) a surfactant phase ; (b) an oil phase; and (c) a benefit agent; wherein the benefit agent is selected from the group consisting of vasoconstrictors, collagen enhancers, anti-edema agents, depigmentation agents; reflectants; detangling/wet combing agents; film forming polymers; humectants; antimicrobial agents; allergy inhibitors; anti-acne agents; anti-aging agents; anti-wrinkling agents, antiseptics; analgesics; antitussives; antipruritics; local anesthetics; anti-hair loss agents; hair growth promoting agents; hair growth inhibitor agents; antihistamines; antiinfectives; inflammation inhibitors; anti-emetics; anticholinergics; vasodilators; wound healing promoters; peptides, polypeptides and proteins; deodorants and anti-perspirants; medicament agents; skin emollients and skin moisturizers; skin firming agents, hair conditioners; hair softeners; hair moisturizers; vitamins; tanning agents; skin lightening agents; antifungals; depilating agents; shaving preparations; external analgesics; perfumes; fragrances; counterirritants; hemorrhoidals; insecticides; poison ivy products; poison oak products; burn products; anti- diaper rash agents; prickly heat agents; make-up preparations; vitamins; amino acids and their derivatives; herbal extracts;

retinoids; flavenoids; sensates; anti-oxidants; skin conditioners; hair lighteners; chelating agents; cell turnover enhancers; coloring agents; pigments; sunscreens and mixtures thereof.

2. A method according to claim 1, wherein the surfactant phase comprises at least one amphoteric surfactant, at least one nonionic surfactant and at least one anionic surfactant.
3. A method according to claim 2, wherein:
  - (a) the amphoteric surfactant is selected from alkyl amphocarboxylates, alkyl betaines, amidoalkyl betaines, amidoalkyl sultaines, alkyl amphophosphates, alkyl phosphobetaines, alkyl pyrophosphobetaines, alkyl sulfobetaines, carboxyalkyl alkyl polyamines, and mixtures thereof;
  - (b) the nonionic surfactant is selected from alcohol ethoxylates, alkyl phenol ethoxylates, fatty acid ethoxylates, fatty acid monoalkylolamide ethoxylates, fatty alcohol propoxylates, fatty amine alkoxylates, fatty acid glyceryl ester ethoxylates, and mixtures thereof;
  - (c) the anionic surfactant is selected from alkyl sulfates; alkyl ether sulfates; alkyl monoglyceryl ether sulfates; alkyl monoglyceride sulfates; alkyl monoglyceride sulfonates; alkyl sulfonates; alkylaryl sulfonates; alkyl sulfosuccinates; alkyl ether sulfosuccinates; alkyl sulfosuccinamates; alkyl amidosulfosuccinates; alkyl carboxylates; alkyl ether carboxylates; alkyl amidoethercarboxylates; alkyl succinates; fatty acyl sarcosinates; fatty acyl amino acids; fatty acyl

taurates; fatty alkyl sulfoacetates; alkyl phosphates; alkyl isethionates, and mixtures thereof.

4. A method according to claim 1, wherein the oil phase has an HLB ranging from about 3 to about 18.
5. A method according to claim 4, wherein the oil phase has an HLB ranging from about 8 to about 11.
6. A method according to claim 1, wherein the oil phase is selected from the group consisting of mineral oil, silicone oil, perfluorocarbons, alkyl esters and mixtures thereof.
7. A method according to claim 1, wherein the oil phase has a viscosity ranging from about 1 to about 500 centistokes.
8. A method according to claim 6, wherein the viscosity ranges from about 10 to about 100 centistokes.
9. A method according to claim 1, wherein said composition comprises (a) from about 60 to about 95% by wt. of the surfactant phase, based on the total composition; and (b) from about 5 to about 40% by wt. of oil the phase, based on the total composition.
11. A method according to claim 1, wherein said composition comprises from about 20 to about 70 wt. % water, based on the total composition.
12. A method according to claim 11, wherein said composition comprises from about 20 to about 50 wt. % water, based on the total composition.
13. A method according to claim 1, wherein the amount of surfactant in the composition ranges from about 10 to about 50 wt%, based on the total composition.

14. A method according to claim 13, wherein the amount of surfactant ranges from about 20 to about 45 wt. %, based on the total composition.
15. A method according to claim 1, wherein the benefit agent is present at from about 0.01 to about 10 wt.%, based on the total composition.
16. A method according to claim 1, wherein said keratinous surface is selected from the skin, hair, and/or nails of a human or animal.
17. The method according to claim 1, wherein the composition is in the form of a gel, a bath, a wash, a mousse, a shampoo, a rinse, a lotion, a cream, a wipe, a brush, a sponge, or a spray.
18. A method for treating acne of a mammal comprising topically applying, to the affected area of the skin, an effective amount of ringing gel composition comprising (a) a surfactant phase; (b) an oil phase; and (c) an anti-acne agent.
19. The method of claim 21, wherein the anti-acne agent is selected from the group consisting of benzoyl peroxide, retinol, elubiol, antibiotics, salicylic acid, and mixtures thereof.
20. A method of cleansing and delivering a benefit agent to hair, skin or nails of a mammal, comprising topically applying to a desired location an effective amount of a ringing gel composition comprising (a) a surfactant phase; (b) an oil phase; and (c) a benefit agent; wherein the benefit agent is selected from the group consisting of vasoconstrictors, collagen enhancers, anti-edema agents, depigmentation agents; reflectants; detangling/wet combing agents; film forming polymers; humectants; antimicrobial agents; allergy inhibitors; anti-acne agents; anti-aging agents; anti-wrinkling agents, antiseptics; analgesics;



antitussives; antipruritics; local anesthetics; anti-hair loss agents; hair growth promoting agents; hair growth inhibitor agents; antihistamines; antiinfectives; inflammation inhibitors; anti-emetics; anticholinergics; vasodilators; wound healing promoters; peptides, polypeptides and proteins; deodorants and anti-perspirants; medicament agents; skin emollients and skin moisturizers; skin firming agents, hair conditioners; hair softeners; hair moisturizers; vitamins; tanning agents; skin lightening agents; antifungals; depilating agents; shaving preparations; external analgesics; perfumes; fragrances; counterirritants; hemorrhoidals; insecticides; poison ivy products; poison oak products; burn products; anti-diaper rash agents; prickly heat agents; make-up preparations; vitamins; amino acids and their derivatives; herbal extracts; retinoids; flavenoids; sensates; anti-oxidants; skin conditioners; hair lighteners; chelating agents; cell turnover enhancers; coloring agents; pigments; sunscreens and mixtures thereof.